



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,825	05/10/2001	Todd A. Schelling	10559-416001/P10374	6463

7590 03/18/2005

Joni D. Stutman-Horn
c/o BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025

EXAMINER

SCHUBERT, KEVIN R

ART UNIT	PAPER NUMBER
----------	--------------

2137

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,825

Applicant(s)

SCHELLING, TODD A

Examiner

Kevin Schubert

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-23 have been considered.

Claim Rejections - 35 USC § 112

5 Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear how splicing the content of a message to make the message instantly executable constitutes "erasing a portion of the
10 BIOS". The applicant provides little detail as to the splicing process and no detail as to how the splicing process arrives at erasing a portion of the BIOS. Appropriate correction is required, including a description of how and why a BIOS is erased in response to splicing a message.

Claim Rejections - 35 USC § 102

15 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

20 (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
25

 Claims 1-4,6-15,16-20, and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Tello, U.S. Patent No. 6,463,537.

30 As per claims 1,8, and 17, the applicant describes a method comprising the following limitations which are met by Tello:

a) receiving, at a BIOS, a message from an authorized party (Col 31, lines 29-60);

Art Unit: 2137

b) authenticating the message (Col 31, lines 29-60);

c) controlling a state of an optional feature of a system resource, using the BIOS,
according to the message (Col 31, lines 29-60);

Tello anticipates the applicant's disclosed invention for the same reasons as given in the
5 first office action. The examiner points the applicant to the specific lines referenced above
instead of the lines referenced in the first office action to better address the applicant's arguments
and further illustrate that Tello provides a system with the limitations of the claim.

Tello provides a system in which a user is allowed access to certain optional features of a
computer, such as which peripherals are allowed to be loaded. Among these peripherals are PCI
10 slots, keyboard addresses, parallel ports, etc (Col 9, lines 12-20) which are all referenced by the
applicant as system features which are optionally enabled in the applicant's system (Applicant:
Specification, page 11).

Furthermore, Tello discloses identifying a user through a smart card and providing access
to certain optional features of the user after identifying him and looking in the flash memory of the
15 security engine on the computer to determine which optional features he has access to. Setting
which features the user has access to can be done at any time as long as the user has
authorization (Col 26, lines 18-33).

The applicant should also note that both Tello and the applicant solve the same problem.
The goal of the applicant's invention is to provide "the capability of enabling optional system
20 features...in situations where an end-user wants to rent or lease system capacity, performance, or
manageability" (Applicant: Specification, page 4). This goal is accomplished by Tello because a
user or administrator can determine which features of the system are enabled and which features
are disabled. This type of situation is applicable to a situation where certain features of a system
are leased or rented as suggested by applicant.

25 As per claims 2, 12, and 18, the applicant discloses the method of the independent claim,
which is anticipated by Tello (see above), with the following limitation which is also anticipated by
Tello:

Art Unit: 2137

Further comprising verifying an identifier in the message against a unique system identifier of the system (Col 9, lines 20-30; Col 26, line 63 to Col 27, line 8);

Tello discloses at least two unique system identifiers. The first is a table of smart card numbers which uniquely identify the smart card so as to match it up with its associated security parameters. (Col 9, lines 20-30). The second is the three hash numbers which are stored on the smart card and the security engine of the computer for authentication purposes (Col 26, line 63 to Col 27, line 8).

As per claims 3,13,19, the applicant discloses the method of the independent claim, which is anticipated by Tello (see above), with the following limitation which is also anticipated by Tello:

Further comprising writing the message into a secure non-volatile location (Col 26, lines 18-43);

The message identifying the optional system features which are enabled or disabled is written in both the smart card and the flash memory of the security engine.

As per claims 4,14, and 20, the applicant discloses the method of claims 3 and 19, which are met by Tello (see above), with the following limitation which is also anticipated by Tello:

Wherein the secure non-volatile location comprises a remote storage (Col 26, lines 18-43);

The secure non-volatile location comprising remote storage can be either the smart card or the flash memory of the security engine where the message identifying the optional system features which are enabled or disabled is stored.

As per claims 6,16, and 22, the applicant discloses the method of the independent claim, which is met by Tello (see above), with the following limitation which is also anticipated by Tello:

Further comprising loading and executing content of the message using the BIOS at run-time (Col 31, lines 29-60).

Art Unit: 2137

As per claims 7, 15, and 23, the applicant discloses the method of claims 1, 8, and 17, which are met by Tello (see above), with the following limitation which is also met by Tello:

Further comprising updating a feature set of the system BIOS according to the message
5 (Col 31, lines 29-60).

The feature sets are the specific peripheral devices which are updated as enabled or disabled at run-time with proper user authentication through a smart card.

As per claim 9, the applicant discloses the system of claim 8, which is anticipated by
10 Tello (see above), with the following limitation which is also anticipated by Tello:

Further comprising a write-once non-volatile unit for storing a public key accessible by the BIOS (Col 15, lines 6-13);

As per claim 10, the applicant discloses the system of claim 8, which is anticipated by
15 Tello (see above), with the following limitation which is also anticipated by Tello:

Wherein the BIOS includes authentication circuitry for authenticating the secure message with a public key (Col 15, lines 6-13);

As per claim 11, the applicant discloses the system of claim 8, which is anticipated by
20 Tello (see above), with the following limitation which is also anticipated by Tello:

Further comprising a write-once non-volatile unit for storing a unique system identifier accessible by the BIOS (Col 9, lines 20-30; Col 26, line 63 to Col 27, line 8);

Claim Rejections - 35 USC § 103

25 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been

Art Unit: 2137

obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tello in further view of Merkin, U.S. Patent No. 6,584,561.

As per claim 21, the applicant discloses the limitations of claim 17, which is met by Tello
10 (see above), with the following limitation which is met by Merkin:

Further comprising slicing the content of the message into an execution path of the BIOS
(Merkin: Col 2, lines 27-34);

Tello discloses all the limitations of independent claim 1. However, Tello fails to disclose
splicing the content of the message into an execution path. Merkin discloses a boot system
15 similar to Tello's system with the main difference that Merkin's system revolves around a CD boot
while Tello's system revolves around a smart card boot. Merkin discloses that the message
received from the CD includes identification data and boot software. Once the data has been
authenticated, the boot software is split from the rest of the message and alone "the boot
software is copied back to the execution part" (Col 2, lines 20-21).

20 It would have been obvious to one of ordinary skill in the art at the time the invention was
filed to combine the ideas of Merkin with those of Tello and splice the content of the message into
an execution path of the BIOS because only the necessary data needs to be sent to the
execution path of the BIOS.

25 Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tello in further
view of Qureshi, U.S. Patent No. 6,769,059.

As per claim 23, the applicant discloses the limitations of claim 17, which is met by Tello
(see above), with the following limitation which is met by Qureshi:

Art Unit: 2137

Further comprising updating a feature set of the BIOS according to the message
(Qureshi: Col 1, lines 34-42);

Tello discloses all the limitations of independent claim 1. Qureshi discloses a secure method for updating a portion of the BIOS, the video BIOS. It would have been obvious to one of
5 ordinary skill in the art at the time the invention was filed to combine the ideas of Qureshi with those of Tello and update a portion of the BIOS if only a portion of the BIOS, like the video portion, needs updating.

10

Response to Arguments

Applicant's arguments, see Remarks, filed 2/9/05, with respect to the Specification as not being mandatory have been fully considered and are persuasive. The objection of the Specification has been withdrawn.

15

Applicant's arguments with respect to claims 1,8, and 17 have been fully considered but they are not persuasive. See the rejection for claims 1,8, and 17 for more information.

Applicant's arguments with respect to claims 2,12, and 18 have been fully considered but they are not persuasive. See the rejection for claims 2,12, and 18 for more information.

20

Applicant's arguments with respect to claims 3 and 19 have been fully considered but they are not persuasive. See the rejection for claims 3 and 19 for more information.

Applicant's arguments with respect to claims 6,16, and 22 have been fully considered but
25 they are not persuasive. See the rejection for claims 6,16, and 22 for more information.

Applicant's arguments with respect to claim 13 have been fully considered but they are not persuasive. See the rejection for claim 13 for more information. As described in the rejection

Art Unit: 2137

for claim 13, the non-volatile memory is the flash memory which stores security information on the users related to which optional features are enabled or disabled for the users.

Applicant's arguments with respect to claims 5 and 21 have been fully considered but they are not persuasive. See the rejection for claim 21 for more information. Furthermore, claim 5 introduces new subject matter which is not described in the Specification in an enabling way. See the rejection for claim 21.

Applicant's arguments with respect to claims 7, 15, and 23 have been fully considered but they are not persuasive. See the rejection for claims 7, 15, and 23 for more information.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2137

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER

ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER